

PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
1736-000001/REC

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Application Number
10/643,673Filed
August 19, 2003First Named Inventor
HYON, Suong-Hyu

On _____

Art Unit
1796Examiner
Susan W. Berman

Signature _____

Typed or printed name _____

Applicant requests review of the final rejection in the above-identified application.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor



Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

David L. Suter

Typed or printed name

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Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

April 22, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/643,673
Filing Date: August 19, 2003
Applicant: Syong-Hyu Hyon
Group Art Unit: 1796
Examiner: Susan W. Berman
Title: ULTRA HIGH MOLECULAR WEIGHT POLYETHYLENE
MOLDED ARTICLE FOR ARTIFICIAL JOINTS AND
METHOD OF PREPARING THE SAME
Attorney Docket: 1736-000001/REC

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**STATEMENT OF REASONS ACCOMPANYING A PRE-APPEAL BRIEF REQUEST
FOR REVIEW AND NOTICE OF APPEAL**

Sir:

In response to the Final Rejection mailed December 22, 2008, Applicants have filed an Amendment After Final, a Notice of Appeal, and a Pre-Appeal Brief Request for Review. Before preparing the Appeal Brief, Applicants respectfully request review of any outstanding rejections that may remain after the Examiner's consideration of the Amendment After Final, in light of the arguments of record and the following remarks.

Procedural Status

Applicants are filing an Amendment After Final (herein the “April 22, 2009 Amendment”) on even date with the current request for pre-appeal brief review. By amendment after final, Applicants have cancelled claims, leaving only two independent claims for review. The claims are not otherwise amended. They have also submitted a new declaration and addressed a provisional obviousness type double patenting rejection to clear up some formal matters to simplify an eventual appeal. The April 22, 2009 Amendment also addresses the substantive recapture and obviousness rejections. To advance prosecution, Applicants have also filed a Notice of Appeal of even date in order to complete their responsive reply to the final rejection. To the extent that the Examiner does not withdraw a rejection on the basis of the evenly filed amendment, Applicants request review by the panel before preparing the Appeal Brief.

Rejection Under 35 U.S.C. § 251

Applicants respectfully request review of this rejection on the basis of their arguments in the April 22, 2009 Amendment and the amendment filed December 3, 2007. There, Applicants explain how there is a factual basis to support a finding that the current claims do not represent an impermissible recapture under 35 U.S.C. § 251.

The recapture rule embodied in 35 U.S.C. §251 is said to prohibit a patentee from obtaining (or “recapturing”) by reissue subject matter that was given up during prosecution of the original claims of the patent being reissued. The reissue of recapture arises when any claim of a reissue application is broader in any way than the claims of the patent being reissued. But broadened claims avoid the recapture issue (and are allowable in a reissue) if broadening aspects are not related to subject matter given up during prosecution. And even if claims have broadening aspects related to surrendered subject matter, the recapture issue is avoided

notwithstanding those broadening aspects if the claims contain narrowing aspects that are not totally unrelated to rejections addressed during prosecution.

For the reasons discussed in their April 22, 2009 and December 3, 2007 Amendments, Applicants urge that the current claims in the Reissue Application contain narrowing aspects not totally unrelated to the rejections. The claims contain a limitation that the compression deformable temperature is below the melting temperature. Had such a limitation been present or offered by amendment during the original prosecution, the claims would have further distinguished over the references cited.

For this reason, the narrowing aspect (temperature below the melting point) is not completely unrelated to the rejections. For these reasons, Applicants respectfully submit the claims are not an improper recapture of surrendered subject matter and respectfully request the rejection be withdrawn.

Rejection Under 35 U.S.C. § 103

Applicants request review of any remaining rejection under § 103(a) for the reasons given in the April 22, 2009 amendment and the December 3, 2007 Amendment. In the final Office Action, Claims 104, 109, 111, 114, 119, 130, 139, 149, 153, 159 and 168-174 stand rejected under 35 U.S.C. as obvious over U.S. Patent No. 5,030,402, Zachariades, issued July 9, 1991 (herein "*Zachariades*") in view of U.S. Patent No. 3,886,056, Kitamura, issued May 27, 1975 (herein "*Kitamura*").

Applicants submit that there is no apparent reason to combine the cited references as suggested in the final rejection unless the current specification is impermissibly used as a guide.

Zachariades discloses compression molding of non-crosslinked UHMWPE. To arrive at the subject matter of the current claims, an apparent reason or motivation must be found to crosslink the UHMWPE before compression molding. The Examiner's position seems to be that


the motivation is now provided by *Kitamaru*, which discloses heating and extending a crosslinked UHMWPE to form a kind of extended structure such a fiber. But this teaching does not provide any reason for a person of skill in the art to modify *Zachariades* to crosslink a UHMWPE before compression. In fact, because *Kitamaru* teaches extending (stretching) a crosslinked UHMWPE after heating to a compression deformable temperature, it actually teaches away from compressing a crosslinked UHMWPE. For these reasons and those discussed in their December 3, 2007 Amendment, Applicants respectfully request the art rejection be withdrawn.

Conclusion

Applicants believe that the pending claims are in an allowable condition and respectfully request an early Notice of Allowance. The Pre-Appeal Brief Panel is invited to telephone the undersigned if that would be helpful to resolving any issues.

Respectfully submitted,

Dated: April 22, 2009

By: 
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